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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,033	08/22/2001	Ieyasu Kobayashi		8235

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Rader Fishman & Grauer
1233 20th Street N W Suite 501
Washington, DC 20036

EXAMINER

RIVERA, WILLIAM ARAUZ

ART UNIT PAPER NUMBER

3654

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,033

Applicant(s)

KOBAYASHI ET AL.

Examiner

William A Rivera

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE of January 14, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Drawings

The drawings are objected to because the drawings showing the film roll, i.e., the ones labeled "1. Measuring Diameters of the Film Roll", "2. Image of Shape of the Film Roll", etc. are not labeled with a numeral, such as --Figure 1--, i.e., the description of each of the drawings should be deleted.

The examiner MUST approve all changes to the drawings, other than informalities noted by the Draftsperson, before the application will be allowed. Applicant is required to submit a sketch or copy of the drawings with the proposed changes highlighted in red ink in response to this Office Action. Any proposed changes to the drawings must be submitted as a separate letter to the Draftsperson. See MPEP 608.02 (r). No changes will be permitted, other than correction of informalities, unless the examiner has approved the proposed changes. However, formal correction of the noted defect(s) can be deferred until the examiner allows the application.

Claim Objections

Claim 16 is objected to because of the following informalities: on line 5, the word "be", after the word "represented", should be replaced with the word --by--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (U.S. Patent No. 4,576,344).

With respect to Claims 1-3 and 16-18, note that Sasaki et al teach a polyester film roll free from wrinkles. Therefore, the difference R between the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-15 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al as applied to claims 1-2 and 16-17 above.

Sasaki et al do not mention the specific dimensions in term of rolling hardness or flexural modulus etc. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the polyester film roll of Sasaki et al as specified in Claims 4-15 and 19-24 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

Response to Arguments

With respect to applicant's remarks regarding the roll and its measurements. Specifically, the applicant mentions that the invention focuses on the difference between the

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maximum diameter and minimum diameter. In the instant case, it should be noted that applicant claims width as one of his criteria. Therefore the emphasis of width in the examiners rejection is relevant. Further, Sasaki's invention has found a way to account for all the unevenness of the film and created a roll which is free from wrinkles. Therefore, a representation of Sasaki's roll shown/drawn in Figure 3 of applicant's graph would be the centerline which is below the maximum convex portion and above the maximum concave portion thereby meeting the recitations of the claim. It should be noted that if it is still the applicant's position that Sasaki does not meet the limitation, then applicant must provide evidence as to why Sasaki does not meet the claim. Mere allegations that the claim is not met are insufficient.

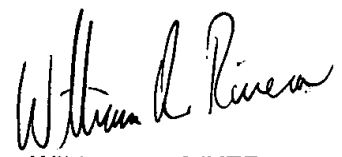
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A. Rivera whose telephone number is (703) 308-2684. The examiner can normally be reached Monday through Friday from 2:00 PM to 10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (703) 308-2688.

Telephone status inquiries regarding this application should be directed to (703) 308-1113. **Facsimile correspondence** for this application should be sent to the following respective numbers:

For **BEFORE FINAL** correspondence: (703) 872-9326
For **AFTER FINAL** correspondence: (703) 872-9327


WILLIAM A. RIVERA
PRIMARY EXAMINER

January 26, 2004